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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Asit Dan

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Gail H. Zarick
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EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/821,445

Applicant(s)

DAN ET AL.

Examiner

Dan Kesack

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed November 13, 2006 has been entered and fully considered.

Claims 1-34 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 8, 15-17, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Solomon, U.S. Patent Application Publication No. 2002/0046157.

Claims 1, 2, Solomon discloses a system and method for negotiations in a distributed network, comprising establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to negotiation and forming a meta contract which controls the negotiations according to the agreed upon protocol, and communicating a request to

negotiate (paragraphs 262, 271 and figure 27), and conducting an automatic negotiation according the negotiation meta contract between the plurality of parties (paragraphs 211, 275), and wherein the codes used to perform negotiations are considered electronic documents (paragraph 28).

Claim 3, Solomon teaches performing at least one sub-negotiation (paragraphs 289 and 296).

Claim 4, Solomon teaches forming an electronic commerce contract (paragraph 265).

Claim 5, Solomon teaches one of the parties is a service provider having a service application on a server computer system and another of the parties is a service requester having a requester application on a client computer system (paragraphs 260-262).

Claim 8, Solomon discloses a method for conducting a negotiation between parties comprising providing a specification of machine-executable rules of negotiation of the parties for generating at least one contract, wherein the specification is agreed upon prior to conducting negotiations (paragraphs 262, 271 and figure 27), and providing a starting state for a contract in accordance with the specification wherein the

starting state is a template defined prior to the negotiation by one of the parties (paragraphs 259-261).

Claims 15, 16, Solomon discloses a method for conducting a negotiation between parties comprising providing a specification of machine-executable rules of negotiation of the parties for generating at least one contract, wherein the specification is agreed upon prior to conducting negotiations, enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules (paragraphs 262, 271 and figure 27), forming a meta contract for controlling a negotiation process in accordance with the specification, at least containing general information related to the formation of the contract (paragraphs 211, 275).

Claim 17, Solomon teaches the negotiation protocol specifies actions to be performed in a negotiation, including making an offer, making a counter-offer and accepting an offer or counter-offer (figure 28).

Claim 22, Solomon teaches the negotiation protocol specifies actions to be performed in a negotiation, including starting a sub-negotiation, committing a sub-negotiation, and/or accepting a sub-negotiation (paragraph 289).

Claim 23, Solomon teaches performing at least one action of the meta contract by a human operator, wherein the meta contract action is setting parameters (figure 1, #1025).

Claim 24, Solomon teaches the client application has a graphical user interface (figure 1, #1030).

4. Claims 1, 6-9, 11-17, 23, and 25-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Batachia et al., U.S. Patent No. 7,103,580.

Claim 1, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising establishing a negotiation protocol that specifies negotiation operations, and is agreed upon by the parties prior to contract negotiation (column 6 lines 26-48), forming a negotiation meta contract to control the contract negotiation in accordance with the negotiation protocol (column 14 line 60 – column 15 line 33), communicating a request to negotiate (column 7 lines 17-23), and conducting an automatic negotiation in accordance with the negotiation protocol (columns 8-9).

Claim 6, Batachia teaches providing for a suspend-negotiation action to take place to enable human intervention during the negotiation (column 6 lines 6-12).

Claim 7, Batachia teaches each party maintains the contract state of the overall negotiation (column 16 lines 49-67).

Claims 8, 33, 34, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising providing a specification of machine-executable rules of negotiation for the parties for generating at least on contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation (column 6 lines 26-48), and providing a starting state for the contract in accordance with the specification (column 14 line 60 – column 15 line 33), wherein the starting state is selectable from one of a previous contract, a publicly defined template, and a template defined prior to the negotiation by one of the parties (column 10 lines 18-26 and column 15 lines 1-12).

Claims 9, 11, Batachia teaches the starting state is selectable from a set of profiles published in a repository by at least one of the parties prior to negotiation (column 12 line 49 – column 13 line 13, and figure 7).

Claims 12-14, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to negotiation (column 6 lines 26-48), creating a template prior to the negotiation in accordance with the negotiation protocol, wherein the template

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contains business logic for performing a negotiation electronically (column 14 line 60 – column 15 line 33), registering the business logic with a server accessible by one or more parties (column 6 lines 49-62), and implementing the business logic in a negotiation conducted automatically (columns 8-9).

Claims 15, 16, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising providing a specification of machine-executable rules of negotiation for the parties for generating at least on contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation (column 6 lines 26-48), enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules (figures 2 and 5), forming a meta contract for controlling a negotiation process in accordance with the specification, at least containing general information related to the formation of the contract (column 14 line 60 – column 15 line 33).

Claim 17, Batachia teaches the negotiation protocol specifies actions to be performed in the negotiation including making an offer, rejecting an offer, making a counter-offer and accepting an offer (column 5 line 42 – column 6 line 5).

Claim 23, Batachia teaches performing at least on action of the meta contract by a human operator, wherein the meta contract action is setting constraints or stopping negotiations (column 6 lines 6-12).

Claims 25-27, Batachia teaches the meta contract contains a set of rules for determining the validity of meta contract actions, the meta contract invokes a method for determining the validity of a meta contract operation, and the meta contract invokes a method for determining a response to a meta contract operation (column 9 line 33 – column 10 line 54).

Claims 28-30, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising providing a specification of machine-executable rules of negotiation for the parties for generating at least on contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation (column 6 lines 26-48), forming a meta contract for controlling a negotiation process in accordance with the specification (column 14 line 60 – column 15 line 33), enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules (figures 2 and 5), wherein at least on of the negotiating parties is an intermediary for facilitating the automatic negotiation (figure 2), and wherein at least the intelligent agents are considered brokers which negotiate on behalf of the parties (column 10 line 55 – column 11 line 16).

Claim 31, Batachia discloses a system and method for negotiation between parties using intelligent agents, comprising establishing a common negotiation protocol that specifies negotiation operations, the protocol being agreed upon by the service

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provider and the service requester prior to negotiation (column 6 lines 26-48), providing a negotiation meta-contract to control the negotiation, in accordance with the negotiation protocol (column 14 line 60 – column 15 line 33), receiving a request to negotiate from the service requester and automatically negotiating with the service requester in accordance with the negotiation meta-contract (figure 5), wherein all steps are processed through the service provider (figure 2).

Claim 32, Batachia teaches automatically negotiating comprises at least sending an offer, sending an acceptance, and sending a counter offer (figure 5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon, as applied above, and further in view of Brothers, U.S. Patent No. 7,035,817.

Solomon fails to teach the publicly defined template is an electronic commerce business-to-business purchasing standard.

Brothers teaches Open Buying on the Internet is a commonly used business-to-business protocol for transactions and payment processing. Since Solomon teaches negotiating contracts to complete transactions, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Solomon to include Open Buying on the Internet because Brothers teaches OBI help to make Internet-based business-to-business commerce easier and more effective (column 1 line 50 – column 2 line 9).

8. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Batachia, as applied above, and further in view of Su, "A Replicable Web-Based Negotiation Server for E-commerce," already of record.

Batachia teaches allowing human intervention of negotiations (column 6 lines 6-12) but fails to teach specific rules and constraints for which to trigger the human intervention action.

Su teaches the client specifies the negotiation protocol to be used by the client's negotiation server. Su also teaches human intervention as an action resulting from the

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occurrence or certain defined events (page 5 column 1). Therefore, it would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Batachia to include the specific events of suspending and resuming negotiations under certain time conditions as defined by the client, as the modification would define the point at which human intervention is required, and would allow automatic negotiation to automatically resume after said human intervention.

Response to Arguments

9. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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